

### REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-8 remain in the application and are subject to examination. Claims 1 and 8 have been amended. No claims have been added or canceled herein.

#### The Rejection:

In "Claim Rejections – 35 USC § 103" on pages 3 to 6 of the above-identified Office Action, claims 1-8 have been rejected as being obvious over U.S. Patent No. 5,228,390 to Jahn in view of U.S. Patent No. 2,853,943 to Royer and U.S. Patent No. 6,490,974 to Wadlinger et al. (hereinafter Wadlinger) under 35 U.S.C. § 103(a).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form. However, claims 1 and 8 have been amended in order to make this even clearer.

#### The Claim Wording:

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a device for throwing-on impression and throwing-off impression in a printing press, comprising:

- an impression cylinder;

- a single cylinder acting as a form cylinder, a blanket cylinder or both;

- an applicator roller;

- a roller throw-on and throw-off bearing for throwing said applicator roller on and off said single cylinder, said roller throw-on and throw-off bearing including a rotatably mounted first actuating element;

a cylinder throw-on and throw-off bearing for throwing said single cylinder on and off said impression cylinder, said cylinder throw-on and throw-off bearing including a rotatably mounted second actuating element;

a coupler forming a coupler mechanism together with said first and said second actuating elements; and

a thrust joint having a dead thrust travel or lost motion and articulately connecting one of said actuating elements to said coupler, said thrust joint having a slot and a joint pin, said joint pin covering a thrust travel within said slot while throwing said single cylinder on and off said impression cylinder, and said slot having a length greater than said thrust travel.

Independent claim 8 contains similar language.

Support for the changes in claims 1 and 8 calling for “dead thrust travel or lost motion” is found on page 6, lines 3-4 of the Specification of the instant application, which state that “Another designation for the ‘dead thrust travel’ is “lost motion.”

In the latest Office Action, in reaction to Applicants’ Brief on Appeal, the Examiner has applied two new references to Jahn and Royer in addition to the previously-applied Wadlinger reference, while dropping the Blaine reference, in the rejection of the claims.

As stated above, claims 1 and 8 now call for the equivalent limitations “dead thrust travel or lost motion.”

#### The Prior Art Does Not Teach Lost Motion:

The Examiner’s new rejection of the claims starts out with the state of the art as disclosed by the primary reference to Jahn. However, the Jahn reference explicitly states in lines 25-29 in column 3 thereof that a lost motion is not required.

Thus, Jahn explicitly **teaches away** from a dead thrust travel or lost motion, which is explicitly recited in claims 1 and 8 of the instant application.

Furthermore, the proposed modification of Jahn to use lost motion, considering that Jahn teaches away from its use, would be a modification which changes the principle of operation of the Jahn reference and is therefore prohibited under MPEP 2143.01 VI.

Thus, even for this reason alone, claims 1 and 8 pending in the instant application are patentable over the prior art.

**The Limitation of a Slot with a Length Greater Than a Thrust Travel is Patentable and Not Shown in the Prior Art:**

The Examiner argues in the last two lines on page 4 of the Office action that the length of the slot is a design choice having no patentable significance.

However, Applicant would like to point out that the criticality of the length of the slot was explained in detail on pages 13 and 14 of the Brief on Appeal. Since the Examiner has apparently overlooked this explanation, the explanation given in the Brief will be repeated below:

**The Patentable Significance of the Length of the Slot Being Greater Than the Thrust Travel:**

*The Examiner next states that "the length of the slot would appear to be a matter of design choice, having no apparent patentable significance and therefore is considered to be obvious to be one having ordinary skill in the art."*

*However, as will be shown below and as discussed in the Specification of the instant application, the length of the slot being greater than the thrust travel provides significant advantages over the prior art.*

*The limitation of claims 1 and 8 calling for the length of the slot being greater than the thrust travel of the pin has patentable significance because it makes it possible for the device and printing press in accordance with the invention to be operated as desired in a first printing operating mode and in a second printing operating mode.*

*In the first printing operating mode, the printing material is printed in the offset printing units and then varnished in the varnishing printing unit. It is required in this first printing operating mode to set a distance of, for example, 1.2 mm between the cylinders 2, 3. See page 32, line 2 of the Specification of the instant application.*

*In the second printing operating mode, the printing material is only printed in the offset printing units and not in the varnishing printing unit. It is required for the second printing operating mode to set a distance between the cylinders 2, 3, which is much greater than the distance in the first printing operating mode and may, for example, be 20 mm. See page 31, lines 23-24 of the Specification of the instant application. Without the distance being much greater, for example 20 mm, the printing material would come into contact with the cylinder 3 in the second printing operating mode and, in that case, the offset printing ink would smear off the printing material onto the cylinder 3.*

*It is advantageous for the operator of the printing machine to be able to choose between the two printing operating modes, because some printing products to be printed require additional varnishing and other printing products do not require such varnishing. It is advantageous for the operator to be able to produce both types of printing products on one and the same machine and not require two different printing machines therefor.*

*In order to be able to correctly adjust both distances of, for example, 1.2 mm and 20 mm between the cylinders 2, 3 for the respective printing operating mode, the claim limitation under discussion – that the length of the slot is longer than the thrust travel of the pin – is indispensable. The mechanism as defined by the invention would not render it possible to operate the printing machine as desired in both printing operating modes without this claim limitation. In other words, without this claim limitation, the invention would not work.*

It would be appreciated if the Examiner would consider all of Applicant's arguments.

Summary:

Clearly, neither Jahn nor Royer nor Wadlinger show:

a thrust joint having a dead thrust travel or lost motion,

the thrust joint having a slot and a joint pin,

the joint pin covering a thrust travel within the slot while throwing a single cylinder on and off an impression cylinder, and

the slot having a length greater than the thrust travel,

as recited in claims 1 and 8 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1 and 8.

Claims 1 and 8 are, therefore, believed to be patentable over the art.

The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1-8 pending in the instant application, are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

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Please charge any fees that might be due with respect to Sections 1.16 and 1.17 to undersigned Counsel's Deposit Account Number 12-1099 of Lerner Greenberg Stermer LLP.

Respectfully submitted,

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